Art Unit: 2815

Attorney Docket No. 2658-0281P

Reply to October 5, 2004 Office Action

Page 2

REMARKS

Applicant thanks the Examiner for the very thorough consideration given

the present application.

Claims 1-8 and 21-26 are now present in this application. Claims 1, 5

and 23 are independent.

Reconsideration of this application is respectfully requested.

Priority Under 35 U.S.C. §119

Applicant thanks the Examiner for acknowledging Applicant's claim for

foreign priority under 35 U.S.C. §119, and receipt of the certified priority

document.

Information Disclosure Statement

Applicant filed an Information Disclosure Statement on November 12,

2004 and asks the Examiner to treat that Information Disclosure Statement on

its merits in the next Office Action.

Rejection Under 35 U.S.C. §102

Claims 1, 3 and 4 stand rejected under 35 U.S.C. §102(a) as being

anticipated by the Applicant's Conventional Art. This rejection is respectfully

traversed.

Art Unit: 2815

Attorney Docket No. 2658-0281P Reply to October 5, 2004 Office Action

Page 3

A complete discussion of the Examiner's rejection is set forth in the Office

Action, and is not being repeated here.

As pointed out in the previous Amendment, filed July 28, 2004, no

admission has been made by Applicant that Figures 4A and 4B qualify as

statutory prior art usable in a rejection of the claims of the present application.

Instead, Applicant has labeled Figures 4A and 4B as "Conventional Art" to

distinguish Applicant's invention from that which is not Applicant's invention.

The Applicant respectfully requests that the Examiner withdraw this art

grounds of rejection, or provide evidence that these figures qualify as statutory

prior art.

In response to this argument, the Office Action states that using the use

of Applicant's Figs. 2, 4A and 4B as admitted prior art is justified because

Applicant has labeled the figures as "conventional" and because it is discussed

in the "background of the invention" portion of the specification.

Applicant respectfully disagrees for the following reasons:

The dictionary definitions of "conventional" differ in meaning, so

Applicant is free to choose what meaning Applicant ascribes to "conventional"

and cannot be held to any arbitrarily one of those definitions.

None of the cited definitions of "conventional" indicate that what is stated

to be conventional is "prior art" to Applicant.

Art Unit: 2815 Reply to October 5, 2004 Office Action

Page 4

Moreover, MPEP 608.01(c) clearly states that the "Background of the Invention" should include a "description of the related art" including "the prior art or other information where appropriate." In other words, the background of the invention is clearly not limited to describing "prior art" but can clearly contain "other information" and "related art." In view of this, describing something as being "conventional" and including that description in the "Background of the Invention" does not constitute a clear, unmistakable and unequivocal admission that the "conventional" material is prior art to Applicant.

Furthermore, a rejection must be based on objective evidence of record, not merely conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). The Office Action has provided no objective evidence of a clear, unmistakable and equivocal admission that claims 1-4 are prior art to Applicant. All that is presented in this regard is speculation.

Applicant has not admitted that Figures 1-4 are prior art to Applicant. In Fleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989) it was held that that for an admission to be used against a party, it must be clear, unequivocal and unmistakable. See also, Harner et al. v. Barron et al., 215 USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991), Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985)

Art Unit: 2815 Reply to October 5, 2004 Office Action

Page 5

and Ex parte The Successor In Interest Of Robert S. McGaughey

(BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

All that Applicant has done is to refer to Figs. 1-4 as "Conventional Art."

Something can be conventional art in the sense that it is practiced in the real

world at the time of Applicant's filing of this Application and may yet not be

prior art to Applicant in any sense, including, for example, under 35 U.S.C.

§103, which forms the basis for this rejection. See, in this regard, the relatively

recent amendments to 35 U.S.C. §103(c).

Under the circumstances, i.e., where Applicant merely describes Figs. 1-

4 as conventional art, the Office Action has not established that Applicant has

made a clear, unequivocal and unmistakable admission on the record that

what is disclosed in Figs. 1-4 is prior art to Applicant. In this regard, the

Examiner is also advised that the initial burden to establish something as prior

art is on the Office as part of its burden of making out a prima facie case of

unpatentability.

During patent examination the PTO bears the initial burden of

presenting a prima facie case of unpatentability. In re Oetiker, 977 F.2d 1443,

1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In re Piasecki, 745 F.2d 1468,

1472, 223 USPQ 785, 788 (Fed. Cir. 1984). If the PTO fails to meet this burden,

then the Applicant is entitled to the patent. Only when a prima facie case is

made, the burden shifts to the Applicant to come forward to rebut such a case.

Art Unit: 2815 Reply to October 5, 2004 Office Action

Page 6

Applicant respectfully submits that the Office has not made out a *prima* facie case of unpatentability at least because it has not made out a *prima facie* 

case that Figs. 1-4 are prior art to Applicant.

At this point no evidence has been provided in support of the position

that the figures are admitted prior art. Citing dictionary definitions, which

clearly differ among themselves, none of which says that "conventional" art is

"prior art," only constitutes evidence that the word "conventional" has several

different meanings, none of which is "prior art."

Moreover, mentioning something as "conventional" in the "Background of

the Invention" certainly does not constitute evidence that what is described as

conventional art is admitted "prior art," when by the terms of the MPEP, it can

constitute evidence of "related art" or "other information."

Moreover, Applicant respectfully submits that independent claim 1

recites a combination of features in a liquid crystal display device, including a

second metal layer comprising a mask having a same pattern and for defining

and forming a separation between the source electrode and drain electrode,

and wherein the first metal layer is patterned using the second metal layer as a

mask so that etched side-walls of the first metal layer and the second metal

layer are substantially aligned, and that these features are not disclosed by the

applied art, which, as noted above, the Office has not established by objective

evidence to even be prior art.

Art Unit: 2815

Attorney Docket No. 2658-0281P

Reply to October 5, 2004 Office Action

Page 7

Claims 3 and 4 depend on claim 1, and therefore are patentable, at least

for the reasons stated with respect to independent claim 1.

Accordingly, reconsideration and withdrawal of this ground of rejection is

respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1-8 stand rejected under 35 U.S.C. §103(a) as being unpatentable

over the Applicant's conventional art Fig. 2, in view of U.S. Patent No. 6,078,365

to Ueda et al. (Ueda). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office

Action, and is not being repeated here.

Initially, Applicant respectfully submits that, for reasons noted above,

the Office Action fails to provide any objective evidence of proper motivation to

modify Fig. 2, which has not been established to be prior art to Applicant and,

thus, this rejection is fundamentally improper.

Furthermore, in rejecting claims under 35 U.S.C. §103, it is incumbent

on the Examiner to establish a factual basis to support the legal conclusion of

obviousness. See, In\_re\_Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598

(Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual

determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148

USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the

Reply to October 5, 2004 Office Action Art Unit: 2815

Page 8

pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Art Unit: 2815 Reply to October 5, 2004 Office Action

Page 9

A suggestion, teaching, or motivation to combine the prior art references

is an "essential evidentiary component of an obviousness holding." C.R. Bard,

Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir.

1998). This showing must be clear and particular, and broad conclusory

statements about the teaching of multiple references, standing alone, are not

"evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at

1617 (Fed. Cir. 1999).

One reason alleged in the Office Action that one of ordinary skill in the

art would have to desire to modify Fig. 2 of the non-prior art on which this

rejection is based, in view of Ueda is "because they are from the same field of

endeavor." Applicant respectfully submits that this reason is not "clear and

particular," but is merely a broad conclusory statement about the teaching of

Ueda, and, standing alone, is not "evidence" of proper motivation to modify Fig.

2 in view of Ueda. See In re Dembiczak, cited above.

The Office Action also states that one of ordinary skill in the art would be

motivated to include aluminum in the electrodes to lower their resistance for

improved conductivity of the circuit components.

In making a rejection under 35 U.S.C. §103, the prior art as a whole

must be considered. The teachings of the applied references are to be viewed

as they would have been viewed by one of ordinary skill in the art. Kimberly-

Clark v. Johnson & Johnson, 745 F.2d 1437, 1454, 223 USPQ 603, 614, (Fed.

Art Unit: 2815 Reply to October 5, 2004 Office Action

Page 10

Cir. 1984); In re Mercier, 515 F.2d 1161, 1165, 185 USPQ 774, 778 (CCPA 1975). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 353 F.2d at 241, 147, USPQ at 393. In re Hedges, et al., 228 USPQ 685 (Fed. Cir. 1986).

In this instance, the Office Action has not established any prior art for Ueda to modify.

Furthermore, Applicant respectfully submits copies of four Korean patent applications, with respect to which the assignee of the instant Application. i.e., LG. Philips LCD Co. Ltd., is the Applicant. These four Korean application provide evidence that the invention disclosed in the instant Application as "conventional art" is not prior art to Applicant under 35 U.S.C. §103(c) because they show that the subject matter described as "conventional" by Applicant was commonly assigned to LG. Philips LCD Co., Ltd. at the time of Applicant's invention. In this regard, please note that Korean Patent Application No. 10-2000-000622 (please refer to Figs. 2 and 3e) was filed on February 10, 2001; Korean Patent Application No. 10-2000-003483 (please refer to Figs. 2, 4, 3d and 5e) was filed on July 27, 2000; Korean Patent Application No. 10-2000-064379 (please refer to Figs. 2, 3f and 4f) was filed on October 31, 2000; and Korean

Art Unit: 2815 Reply to October 5, 2004 Office Action

Page 11

Patent Application 10-2001-0084923 (please refer to Figs. 1, 2d, 4, 5d and 7)

was filed on December 26, 2001. These patent applications appear to show the

same structure as Figs. 1 and 2 of the instant invention, thereby providing

objective factual evidence that the claimed subject matter of claims 1-8 is not

prior art to Applicant for purposes of this rejection of claims 1-8 under 35 U.S.C.

§103.

Moreover, Fig. 2, which has not been established as prior art to Applicant

under 35 U.S.C. §103(c), does not indicate any problems such as a need for

improved conductivity of its circuit components. Only Applicant's disclosure

discloses a problem that needs to be solved and a solution for that problem.

This argument, presented in the previous Amendment filed on September

28, 2004, has not been addressed in the outstanding Office Action, thereby

failing to comply with the explicit requirements of MPEP §707.07(f) for the

Office Action to address all arguments raised by Applicant.

This rejection is treating Applicant's disclosure as prior art with no

proper basis on which to do so. In making its determination the prior art must

be viewed without reading into that art the patent's teachings. In re

Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969). Moreover,

"discovery of the source of a problem" is part of the "subject matter as a whole"

to be considered in determining obviousness - see Sponnoble, cited above.

?

Reply to October 5, 2004 Office Action

Page 12

In this regard, the Office Action provides no objective evidence of prior art

disclosing the problem that Applicant overcomes.

Further, with regard to independent claim 5, Ueda consistently discloses

adjacent films being patterned in almost the same shape. With particular

regard to layer 79, Ueda teaches the "metal film 79, the n+ type a-Si film 78, an

a-Si film 77, and an SiNx film 76 as a gate insulating film are continuously

etched and patterned into almost the same shape. The Applicant respectfully

submits that "same" and "almost the same" are not the same with respect to a

semiconductor layer having the same pattern as the first metal layer.

Therefore Ueda fails to teach or suggest a combination of elements in a

liquid crystal display device, including a source electrode and a drain electrode

over the first semiconductor layer, the source electrode and drain electrode

including a first layer and a second layer patterned to form a separation region

between the source and drain electrodes; and a second semiconductor layer

beneath the first metal layer and having a same pattern as the first metal layer,

as recited in independent claim 5. Applicant continues to present this

argument as valid despite the comments in the Office Action that Ueda is not

relied on for this feature, because the Office Action fails to establish this

feature in any prior art whatsoever.

In response to this argument, the Office Action states that Ueda was not

relied on to teach the second semiconductor layer having the source electrode 5

Attorney Docket No. 2658-0281P Application No.: 10/028,768 Art Unit: 2815

Reply to October 5, 2004 Office Action

Page 13

and the drain electrode 7 patterned to form a separation region and the second semiconductor layer 17 beneath the electrodes having a same pattern as the

electrodes. Ueda was relied on to teach the multilayer electrode.

The prior art must be considered as a whole. W.L. Gore & Associates v.

Garlock, Inc., 721 F.2d 1540, 1550 (Fed. Cir. 1983), cert. denied, 469 U.S. 851

(1984). "It is impermissible within the framework of section 103 to pick and

choose from one reference only so much of it as will support a given position, to

the exclusion of other parts necessary to the full appreciation of what such

reference fairly suggests to one of ordinary skill in the art." Application of

Wesslau, 353 F.2d 238, 241 (C.C.P.A. 1965); Bausch & Lomb, Inc. v. Barnes-

Hind/Hydrocurve, 796 F.2d 443, 448 (Fed. Cir. 1986), cert. denied, 484 U.S.

823 (1987).

The outstanding rejection fails to take into consideration the overall

teachings of Ueda, including these aspects of Ueda that teach away from

making the proposed reference combination.

With regard to dependent claims 2-4 and 6-8, Applicant submits that

claims 2-4 and 6-8 depend, either directly or indirectly, from independent claims

1 and 5, which are allowable for the reasons set forth above, and therefore

claims 2-4 and 6-8 are allowable based on their dependence from claims 1 and

5. Reconsideration and allowance thereof are respectfully requested.

Art Unit: 2815 Reply to October 5, 2004 Office Action

Page 14

With respect to claims 21-26, although the caption of the rejection found on page 5 of the Office Action does not mention that claims 21-26 are rejected, these claims are treated in the body of the rejection and in the Summary of the Office Action as being rejected and will be addressed below as being rejected on

As pointed out above with respect to claims 1-8, the Office Action has not established any prior art for Ueda to modify and the rejection is improper for at least this reason.

their merits, as follows.

Additionally, the Office Action has not provided proper motivation to combine the improper, non-established-to-be, prior art with Ueda. One alleged reason that one of ordinary skill in the art would have to desire to modify Fig. 2 of the non-prior art on which this rejection is based, in view of Ueda is "because they are from the same field of endeavor." Applicant respectfully submits that this reason is not "clear and particular," but is merely a broad conclusory statement about the teaching of Deardorff, and, standing alone, is not "evidence" of proper motivation to modify Figs. 1-3 in view of Deardorff. See In re Dembiczak, cited above.

This argument, presented in the previous Amendment filed on September 28, 2004, has not been addressed in the outstanding Office Action, thereby failing to comply with the explicit requirements of MPEP §707.07(f) for the Office Action to address all arguments raised by Applicant.

Art Unit: 2815

Reply to October 5, 2004 Office Action

Page 15

The Office Action also states that one of ordinary skill in the art would be

motivated to include aluminum in the electrodes to lower their resistance for

improved conductivity of the circuit components. This is not considered

persuasive for a number of reasons, including the fact that the Office Action

provides no objective evidence of prior art disclosing the problem that Applicant

overcomes, and because in Ueda, ohmic contact layer 79 is disclosed to be

transparent, whereas aluminum is not transparent, so the alleged motivation

to use aluminum is contradicted/taught away from by Ueda's own disclosure.

Similar comments apply to dependent claims 24-26.

Accordingly, reconsideration and withdrawal of this rejection is

respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed,

accommodated, or rendered moot. Applicant therefore respectfully requests that

the Examiner reconsider all presently outstanding rejections and that they be

withdrawn. It is believed that a full and complete response has been made to the

outstanding Office Action, and as such, the present application is in condition

for allowance.

If the Examiner believes, for any reason, that personal communication will

expedite prosecution of this application, the Examiner is invited to telephone

Art Unit: 2815

Attorney Docket No. 2658-0281P Reply to October 5, 2004 Office Action

Page 16

Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By:

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Attachments:

Korean Patent Application 10-2000-0006221 Korean Patent Application 10-2000-0043483 Korean Patent Application 10-2000-0064379 Korean Patent Application 10-2001-0084923